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10/584,062	06/22/2006	Tetsuyuki Nakayasu	2006_0976A	8967
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EXAMINER				
BENZON, GREG C				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/584,062

**Applicant(s)**

NAKAYASU, TETSUYUKI

**Examiner**

GREG BENZON

**Art Unit**

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This application has been examined. Claims 1-15 are pending.

#### ***Making Final***

Applicant's arguments filed 05/06/2009 have been fully considered but they are not persuasive.

The claim amendments regarding -- 'detecting data that is cited from mail data created by a creator different from a creator of the received mail' -- alter the scope of the claims but do not overcome the disclosure by the prior art as shown below.

The Examiner is maintaining the rejection(s) using the same grounds for rejection and thus making this action FINAL.

#### ***Response to Arguments***

Applicant's arguments filed 05/06/2009 have been fully considered but they are not persuasive.

The Applicant presents the following argument(s) *[in italics]*:

*...[the prior art] does not disclose or suggest a cited data detecting section operable to detect a cited part of the received video data or audio data that is cited from mail data created by a creator different from a creator of the received mail...*

The Examiner respectfully disagrees with the Applicant.

Gupta disclosed (re. Claim 1) detecting data that is cited from mail data (Gupta- Paragraph 63, 'multimedia presentations' ) created by a creator different from a creator of the received mail. (Gupta- Paragraph 7, 'another student can respond in a subsequent annotation')

The Examiner notes that the basis of the annotations are multimedia presentations which are created independently of the Gupta system. Thus where the claimed *cited data* is the original multimedia presentation disclosed by Gupta, then it would have been obvious that the multimedia presentation could be created by any user. Furthermore Gupta Figure 22, Paragraph 146 displays both the original multimedia presentation ('*cited data created by a different user*') along with the subsequently added annotations ('*by the creator of the received mail*')

Furthermore in order to expedite prosecution the Applicant is respectfully requested to review prior art by Ozkan (US Patent 6748421) regarding detecting data that is cited from mail data created by a creator different from a creator of the received mail.

### ***Priority***

This application claims benefits of priority from Foreign Application 2003-429445 filed December 25, 2003.

The effective date of the claims described in this application is December 25, 2003.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (US Publication 2005/0081159) further in view of McLaren (US Patent 6064794 ).

Gupta disclosed (re. Claim 1) an electronic mail processing apparatus comprising: a data receiving section operable to receive mail data including video data or audio data; (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79) a cited data detecting section operable to detect a cited part of the received video data or audio data as cited data from the mail data received by the data receiving section; (Gupta-Paragraph 96-Paragraph 98) and a reproduction control section operable to

control a reproducing method of the received mail data. (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79)

Gupta disclosed (re. Claim 1) detecting data that is cited from mail data (Gupta-Paragraph 63, 'multimedia presentations' ) created by a creator different from a creator of the received mail. (Gupta- Paragraph 7, 'another student can respond in a subsequent annotation')

The Examiner notes that the basis of the annotations are multimedia presentations which are created independently of the Gupta system. Thus where the claimed *cited data* is the original multimedia presentation disclosed by Gupta, then it would have been obvious that the multimedia presentation could be created by any user. Furthermore Gupta Figure 22, Paragraph 146 displays both the original multimedia presentation ('*cited data created by a different user*') along with the added annotations ('*by the creator of the received mail*').

While Gupta substantially disclosed the claimed invention Gupta did not disclose (re. Claim 1) wherein the reproduction control section controls the reproduction method so that a reproduction method for the cited data is deferent from a reproduction method for data other than the cited data in the received mail data.

McLaren disclosed (re. Claim 1) wherein the reproduction control section controls the reproduction method so that a reproduction method for the cited data is different from a reproduction method for data other than the cited data in the received mail data. (McLaren-Column 5 Lines 40-65)

Gupta and McLaren are analogous art because they present concepts and practices regarding the playback control of video segments. At the time of the invention it would have been obvious to combine McLaren into Gupta. The motivation for said combination would have been to facilitate various trick-play modes by controlled selection of "replay" locations. (McLaren-Column 2 Lines 20-35)

Claim 8 (re. method) is rejected on the same basis as Claim 1.

The motivation to combine described in Claim 1 applies to Claim 8.

Gupta-McLaren disclosed (re. Claim 2,9) wherein the reproduction control section controls the reproduction speed of the mail data so as to reproduce the data other than the cited data in the received mail data at a first speed, and reproduce the cited data at a second speed which is faster than the first speed. (McLaren-Column 5 Lines 40-65)

The motivation to combine described in Claim 1 applies to Claims 2,9.

Gupta-McLaren disclosed (re. Claim 3,10) wherein the cited data includes information relating to a creator of the mail data in a specified region, (Gupta-Paragraph 52, Paragraph 61-63) and the cited data detecting section detects the cited portion by using the information relating to the creator. (Gupta-Paragraph 52, Paragraph 61-63)

The motivation to combine described in Claim 1 applies to Claims 3,10.

Gupta-McLaren disclosed (re. Claim 4,11) wherein the video data or audio data included in the cited data is data compressed by a specified compressing method (McLaren-Column 5 Lines 40-65, Column 6 Lines 60-65) and having a header portion in which information relating to a creator of the mail data is recorded. (Gupta-Paragraph 52, Paragraph 61-63)

The motivation to combine described in Claim 1 applies to Claims 4,11.

Gupta-McLaren disclosed (re. Claim 5,12) wherein the cited data includes information relating to a creator of the mail data in a form of a digital watermark embedded in the video data or audio data, and the cited data detecting section detects



the cited data by using the information relating to the creator embedded in a form of a digital watermark.

The Examiner notes that at the time of the invention the use of digital watermarks with email and multimedia content was well-known in the networking art. It would have been obvious to use digital watermarks in the Gupta-McLaren in order to provide a unique identifier for said content and content creator.

The motivation to combine described in Claim 1 applies to Claims 5,12.

Gupta-McLaren disclosed (re. Claim 6,13) comprising a data creating section operable to create the mail data for transmission including video data or audio data, wherein when creating the mail data, the data creating section stores information relating to a creator of the mail data in a specified recording region of the video data or audio data. (McLaren-Paragraph 61-Paragraph 63)

The motivation to combine described in Claim 1 applies to Claims 6,13.

Gupta-McLaren disclosed (re. Claim 7,14) a data creating section operable to create the mail data for transmission including video data or audio data, wherein when creating the mail data, the data creating section embeds information relating to a creator of the mail data in a form of a digital watermark in the video data or audio data.

The Examiner notes that at the time of the invention the use of digital watermarks with email and multimedia content was well-known in the networking art. It would have been obvious to use digital watermarks in the Gupta-McLaren in order to provide a unique identifier for said content and content creator.

The motivation to combine described in Claim 1 applies to Claims 7,14.

Gupta-McLaren disclosed (re. Claim 15) an electronic mail processing system comprising a first mail processing apparatus and a second mail processing apparatus which exchanges electronic mails with the first mail processing apparatus, a) the first mail processing apparatus including: a data transmitting and receiving section operable to transmit and receive mail data including video data or audio data, (Gupta-Paragraph 92,Paragraph 163,Paragraph 77-Paragraph 79) a cited data detecting section operable to detect a cited part of video data or audio data as cited data from the received mail data, (Gupta-Paragraph 96-Paragraph 98) a reproduction control section operable to control a reproducing method of the received mail data (Gupta-Paragraph 92,Paragraph 163,Paragraph 77-Paragraph 79)

so that a reproduction method for the cited data is deferent from a reproduction method for data other than the cited data in the received mail data, (McLaren-Column 5 Lines 40-65)

and a data creating section operable to create mail data for transmission by adding information relating to a creator of the mail data to video data or audio data included in the mail data, (Gupta-Paragraph 52, Paragraph 61-63) and b) the second mail processing apparatus including: a data transmitting and receiving section operable to transmit and receive mail data, (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79)

and a data editing section operable to edit the mail data received in the data transmitting and receiving section, (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79)

wherein the second mail processing apparatus creates a reply mail (Gupta-Figure 19, Paragraph 127) including as cited data a part or whole of video data and audio data included in the received mail data, by the data editing section, and transmits a reply mail to a sender of the received mail data through the data transmitting and receiving section. (Gupta-Figure 19, Paragraph 127)

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to the enclosed PTO-892 form.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREG BENGZON whose telephone number is (571)272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. B./  
Examiner, Art Unit 2444

/William C. Vaughn, Jr./  
Supervisory Patent Examiner, Art Unit 2444